

## **REMARKS**

### **Telephone Interview Summary**

Examiner Harbeck and Supervisory Examiner Sough discussed the present application with Applicant's attorney on February 12, 2006. Applicant's attorney appreciated the opportunity to discuss the application. Independent claims 1, 6, 9, 10, and 18 were discussed. Applicant pointed out that the cited references do not disclose an important aspect of the present invention as has been suggested in the office actions. Applicant argued that the cited references do not teach comparing applicant rating data with financial institution selection criteria to locate financial card offers for an applicant based on financial institution selection criteria. Applicant then explained the benefits of the invention over the prior art. Financial institutions benefit by locating new customers who meet their specific selection criteria while applicants benefit by being matched with financial institutions that are more likely to accept them as customers.

The prior art references—which disclose only online credit applications—require consumers to complete the application process before they find out whether they will be rejected or accepted. Although financial web sites may organize online applications in a variety of different ways, they do not facilitate the selection process for either party. An applicant may be required to apply for many credit cards before finding a financial institution that will accept the application. A financial institution may be required to analyze many applications before finding an applicant that it would like as a customer. The present invention uses applicant data and financial institution selection criteria to match applicants with financial institutions so that the financial institutions find

applicants they are more likely to want as customers and applicants find financial institutions that are more likely to accept them.

Applicant proposed amending the claims to indicate more clearly that applicant data and financial institution selection criteria are compared to locate financial card offers for an applicant. No agreement regarding the claims was reached.

#### **Request to Withdraw of Finality of Office Action**

On December 20, 2005, Applicant submitted an Amendment After Final with no amended claims and with remarks explaining how the claimed invention differs from the cited references. In the Amendment After Final, Applicant requested that Examiner Harbeck withdraw the finality of the Office Action so that Applicant's representative could have an opportunity to discuss the present application with the examiner currently assigned to the application. It was not until the final office action was sent that Applicant learned that Examiner Vincent was no longer assigned to the present application. Applicant requested an opportunity to discuss the present application with the examiner currently assigned to the case prior to being required to respond to a final office action.

During the interview, Applicant asked once again to have the finality of the office action withdrawn. Applicant was advised that a change in examiners between the first and final office actions and the lack of an opportunity to interview the current examiner prior to the issuance of a final office action was not an appropriate basis for withdrawing the finality of the office action.

Although an opportunity to interview is not considered an appropriate basis for withdrawing the finality of the office action, it was apparent during the February 12 interview there was some doubt as to whether the cited references render the present invention obvious. Examiner Harbeck indicated in the interview that he wanted another opportunity to review the references and possibly, to search for other references. The telephone interview summary dated February 24, 2006 confirms the intent of the examiner to perform another prior art search.

If the opportunity to interview the examiner had occurred prior to issuance of the final office action, the examiner would have had a better understanding of the invention and been able to explain to Applicant more clearly in the final office action how the cited references applied to claimed invention or if the examiner determined an additional search was required, to conduct the search. Instead, Applicant has been required to file a Request for Continued Examination so that the examiner has more time to consider the claims, the application of the prior art to the claims, and to conduct another search. While an opportunity to interview is not considered an appropriate basis for withdrawing the finality of the office action, it is apparent that the lack of an opportunity to discuss the application with the current examiner has resulted in additional expenses for Applicant and a delay in prosecution of the application.

### **Claim Rejections under 35 U.S.C. § 103**

The Examiner has maintained the rejection of claims 1-9 and 25 under 35 U.S.C. § 103(a) as being unpatentable over Norris (U.S. Pat. 6,105,007) in view of “New Sites on the World Wide Web Management Accounting” (Reference E) and “Metairie Bank

Joins the Internet" (Reference B). It is the Examiner's position Norris teaches Applicant's invention except for locating and presenting financial card offers. References E and B are believed to teach multiple credit card offers from multiple financial institutions. It is the Examiner's position it would have been obvious to one of ordinary skill in the art to modify the Norris invention to offer multiple cards from multiple institutions.

The Examiner has further maintained the rejection of claims 10-24 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Norris, Reference B, and Reference E in further view of Lockwood (U.S. Pat. 6,289,319). It is the Examiner's position Norris, Reference B, and Reference E teach the limitations of claim 10 except for a first database for storing financial institution data comprising financial institution selection criteria and financial offering data for participating financial institutions and a second database for storing credit history data, and one or more servers adapted as claimed. It is the Examiner's position Lockwood teaches these additional features including selection criteria for automatically processing financial applications and that it would be obvious to one of skill in the art to modify or interpret the combination of Norris, Reference B, and Reference E to implement the above features related to selection criteria as taught by Lockwood because to do so would have been an improvement in making sure the customer gets the best product and the bank gets the proper level of risk so they can make more money.

The Examiner states that in response to the June 8 Office Action no arguments were made concerning the Examiner's prima facie case of obviousness. Applicant respectfully disagrees. To establish a prima facie case of obviousness, the Examiner

must provide 1) some suggestion or motivation to modify the reference or to combine reference teachings, 2) a reasonable expectation of success, and 3) a combination of references that teach or suggest all the claim limitations. Applicant specifically stated in the response to the June 8 Office Action that “the cited references, alone or in combination, do not teach selection or location of financial offers for an applicant and therefore, cannot support the present rejections.” Applicant respectfully submits that a statement alleging the failure of the prior art references alone or in combination to teach specific claim elements is an argument concerning prima facie obviousness because it relates to a failure to meet the third requirement for establishing prima facie obviousness.

Regardless of whether there is any motivation to combine Norris, Reference E, and Reference B, the combination simply fails to teach or suggest all of the claim limitations. Each of the references is directed to online credit card applications. Each reference states explicitly, or in some cases simply suggests, that a user may complete an online credit card application to obtain a credit card. In some instances, a user may make a selection from a plurality of applications that have been made available at one web site. However, none of the references teach or even suggest card offers that are selected or located for the applicant according to the applicant's application data and/or rating and selection criteria for a financial institution.

Only the Norris reference provides any discussion regarding the use of application and rating data (Col. 6, lines 33-51) and after applying for a loan or credit card states in Col. 6, lines 45-51 that “[t]he applicant's credit report is obtained from the credit bureau by transaction processor 10, evaluated using an underwriting model 90, to

be described more fully below, and a decision is made based on the results of the evaluation by underwriting model 90, which results are in the form of a score and an associated risk factor, to grant or deny the loan or credit card application.” Norris requires a user to apply for a loan or credit card before the applicant’s credit data is used for any reason. In particular, the credit data is used only for underwriting purposes to approve the loan or credit card for which the user is applying. Applicant respectfully submits that Norris does not teach or even suggest using application and/or rating data and comparing it to financial institution selection criteria to select financial card offers for a user. The other cited references have a similar deficiency and fail to consider a user’s application and/or rating data and financial institution selection criteria to select financial card offers for a user. In the prior art, it is only after the user has selected a credit card and completed the application that the application data and/or rating data are used. More importantly, it is only after the user has selected a credit card and completed the application that an applicant might find out that the financial institution does not want the applicant as a customer. Applicant respectfully submits that prior art references directed to the use of application/credit data for underwriting purposes cannot support rejections of the claims as amended.

The Examiner asserts the claims relate to selection and location of financial card offers on behalf of an applicant and that the previous Office Action demonstrated that the prior art teaches selection and location of financial card offers on behalf of an applicant. Applicant respectfully submits, however, neither the previous Office Action nor the final Office Action considers the way in which application data and/or rating data and financial institution selection criteria is used by the present invention to select and

locate financial cards for an applicant. As explained previously, the prior art fails to teach selection and location of financial card offers using application data and/or rating data and financial institution selection criteria. Instead, it teaches use of application and/or rating data to underwrite a loan or credit card.

Applicant respectfully submits the amended claim indicate clearly that offers are selected or located for the applicant using credit data/rating information and selection criteria and that the selected offers are presented to the applicant for review. An applicant may then choose one of the offers that has been located according to the application/credit rating data and financial institution selection criteria. Applicant respectfully submits the Norris, Reference E, and Reference B prior art references relied upon by the Examiner which teach the availability of online loan or credit applications and the use of ratings to approve loan or credit applications cannot support the rejection of Applicant's amended claims which are directed to selecting or locating offers for a credit applicant. Applicant further respectfully submits that Norris, Reference E, and Reference B cannot support the rejection of the claims and therefore, cannot be combined with Lockwood to support the rejection of the claims.

### **Conclusion**

The locating of financial card offers based on applicant data and selection criteria of financial institutions is unique to the present invention. It assists financial institutions in locating new customers who meet their specific selection criteria. It assists applicants in finding credit card applications that meet their needs and that are likely to be accepted by issuing financial institutions. It respectfully submitted the amended claims

emphasize the unique features of the present invention and distinguish the invention over the cited references. Applicant respectfully submits that the present application is in condition for allowance, and such action is earnestly requested.

Respectfully submitted,

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